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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,171	11/12/2003	Sarah Jean Barrios	200316394-1	8241

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

WILLIAMS, KIMBERLY A

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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04/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

Office Action Summary	Application No. 10/712,171	Applicant(s) BARRIOS, SARAH JEAN	
	Examiner Kimberly A. Williams	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant please note that a new examiner has been assigned to this application.

Response to Arguments

1. Applicant's arguments with respect to claim 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7,9,10,13,14 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Flannery (US 6594405).

Regarding **claim 1**, Flannery teaches a method (method and apparatus for preprinted forms completion) comprising: scanning a page (col. 3, lines 38-39 and 56-58; col. 4, lines 6-10); locating at least one device on the page (the image of the scanned form is provided to the background; col. 3, lines 39-41, 58-60); printing information onto the page without printing information on the at least one device (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Regarding **claim 2**, Flannery teaches storing a template of the scanned page (col. 3, lines 50-54, and line 67- col. 4, line 4) where the template contains the location and size of the at least one device (parameters of the background; col. 4, lines 20-33).

Regarding **claim 3**, Flannery teaches a method (method and apparatus for preprinted forms completion) comprising: scanning a first page (col. 3, lines 38-39 and 56-58; col. 4, lines 6-10); locating the position and size of at least one object on the first page (col. 4, lines 20-36): aligning information to fit onto the first page without the information encroaching onto the at least one object on the first page (col. 4, lines 36-45)

Regarding **claim 4**, Flannery teaches that the information aligned is text (col. 4, lines 36-45).

Regarding **claim 5**, Flannery teaches that the information aligned is graphical (the operator enters text or other information col. 3, lines 43-49; col. 4, lines 36-39).

Regarding **claim 6**, Flannery teaches printing the aligned information onto the first page (col. 4, lines 52-54).

Regarding **claim 7**, Flannery teaches printing the aligned information onto a second page, where the second page is essentially a copy of the first page (the entered text (foreground) can be printed out without the background (form) col. 3, lines 35-37, which reads on the second page).

Regarding **claim 9**, Flannery teaches receiving the information to be aligned as digital information (col. 3, lines 43-45).

Regarding **claim 10**, Flannery teaches a method (method and apparatus for preprinted forms completion) comprising: scanning a page of stationery (col. 3, lines 38-39 and 56-58; col. 4, lines 6-10); locating at least one device preprinted on the stationery (the image of the scanned form is provided to the background; col. 3, lines 39-41, 58-60); automatically formatting a string of text such that the string of text is positioned correctly for the page of stationery, with respect to the location of the at least one device (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Regarding **claim 13**, Flannery teaches printing the formatted string of text onto the stationery (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Regarding **claim 14**, Flannery teaches that the string of text is created in a word processing program (col. 3, lines 58-60).

Regarding **claim 16**, Flannery teaches a system, comprising: a scanning device (22) configured to generate a digital representation of a page (preprinted form) placed onto the scanning device; a processor (32) configured to detect the location of at least one object in the digital representation of the page (the image of the scanned form is provided to the background; col. 3, lines 39-41, 58-60); a printing device (24); the processor configured to print information on the page in a location that does not overlap with the location of the at least one detected object in the digital representation of the

page (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Regarding **claim 17**, Flannery teaches that the system is connected to the Internet with a communication link (col. 3, lines 4-8).

Regarding **claim 18**, Flannery teaches that the scanning device is integrated into the printing device (col. 3, lines 22-25).

Regarding **claim 19**, Flannery teaches a system, comprising: a scanner (22) configured to generate a digital representation of a page placed onto the scanner; a computer (20) connected to the scanner, the computer configured to detect the location of at least one object in the digital representation of the page; a printer (24) connected to the computer; the computer configured to print information on the page in a location that does not overlap with the location of the at least one detected object in the digital representation of the page (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Regarding **claim 20**, Flannery teaches that the system is connected to the Internet with a communication link (col. 3, lines 4-8).

Regarding **claim 21**, Flannery teaches a means (22) for scanning a page; a means (processor 32) for detecting the size and location of objects printed on the page (parameters of the background; col. 4, lines 20-33); a means (processor 32) for aligning information to fit on the page while avoiding the detected objects; a means (24) for

printing the aligned information onto the page (text is entered as foreground information and the foreground is printed on the scanned preprinted form; col. 3, lines 43-45, 49-50; col. 4, lines 52-54; fig. 4, steps 114,118,120,112,130,132).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flannery in view of Ebner et al. (US 5452094).

Regarding **claim 8**, Flannery fails to specifically disclose scanning a second page to capture the information to be aligned.

Ebner teaches placing an original document, such as a letterhead or logo on a scanner (10) to be saved (col. 6, lines 57-col. 7, line 17). Then, in a logo merge or overwrite print mode, an original document without a logo is scanned and transmitted to an image processor (12) that merges the two together and prints them out (fig. 4; col. 9, line 50 – col. 10, line 2).

Regarding **claims 11 and 12**, Flannery fails to specifically disclose that the device is a letterhead or logo.

Ebner teaches that the device is a letterhead or logo.

Flannery could be modified to store letterhead and logos for subsequent printing with a scanned page. This modification would have been obvious to one of ordinary skill in the art at the time of the invention since Flannery already stores preprinted forms and has a keyboard, pointing device and scanner for inputting a scanned page.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flannery in view of Fong et al. (US 5987231).

Regarding **claim 15**, Flannery fails to specifically disclose that the string of text is read from a file.

Fong teaches a method of printing user input data on preprinted forms wherein the user can enter data via a keyboard or prestored data (col. 3, lines 6-23).

Flannery could be modified to store input text data. This modification would have been obvious to one of ordinary skill in the art at the time of the invention since it would be advantageous for subsequent use.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly A. Williams whose telephone number is (571) 272-7471. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly A Williams/
Primary Examiner, Art Unit 2625

KAW
April 16, 2008